

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 20828/0205163-US0	
	Application Number 10/516,432-Conf. #5126	Filed July 29, 2005	
	First Named Inventor Manfred Dick et al.		
	Art Unit 3735	Examiner A. M. Farah	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant /inventor.
 assignee of record of the entire interest.
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
 is enclosed. (Form PTO/SB/96)
 attorney or agent of record.

Registration number 44,586



Signature

Thomas P. Carty
Typed or printed name

- attorney or agent acting under 37 CFR 1.34.
 Registration number if acting under 37 CFR 1.34. _____

011 49 69 713 7798 0

Telephone number

November 13, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
 Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

Docket No.: 20828/0205163-US0
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Manfred Dick et al.

Application No.: 10/516,432

Confirmation No.: 5126

Filed: July 29, 2005

Art Unit: 3735

For: METHOD FOR CONTROLLING A DEVICE
FOR TREATING THE HUMAN EYE

Examiner: A. M. Farah

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In support of the Pre-Appeal Brief Request for Review filed on even date herewith in the above-identified application, Applicants hereby respectfully requests reconsideration of the application based on the following remarks.

Remarks**Background:**

Claims 14-28 are pending.

In the final Office Action dated July 13, 2007, claims 14-28 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,130,835 to Cox et al. ("Cox et al.")

In response to the final Office Action, filed on September 30, 2007, reconsideration of the rejections to claims 14-28 was requested without amending the claims. An English language translation of the priority document corresponding the present application filed on May 31, 2002 was submitted with the response together with a statement that the translation is accurate. Thus, applicant's claim for priority to May 31, 2002 was perfected.

An Advisory Action dated October 13, 2007 indicated that the request for reconsideration had been considered but did not place the application in condition for allowance.

Argument:

It is respectfully submitted that the rejections under 35 U.S.C. 102(e) are clearly improper based upon clear errors in facts.

Independent Claim 25:

Independent claim 25 recites a device for treating a human eye using laser irradiation, that includes at least the feature of "a pachymetry apparatus configured to measure a pachymetry of the eye". Support for that feature is found in the original application as filed, and also in the priority document. See Translation of Priority Document (submitted with the response to final), for example, at claim 11.

Applicants respectfully submit that, at least with regard to disclosing the feature of a pachymetry apparatus, Cox et al. is not prior art to the present application.

The present application claims priority to an application filed on May 31, 2002. Cox et al. was filed after the priority date of the present application, on December 20, 2002, but claims priority

to a provisional application No. 60/368,643 filed on March 28, 2002.¹ Thus, the 35 U.S.C. 102(e) date of the Cox et al. reference is the date of the priority application (March 28, 2002), only if the priority application “properly supports the subject matter used to make the rejection.” See MPEP 706.02(f)(1)I.(B).

Applicants have conducted a thorough review of U.S. provisional application 60/368,643 and have concluded that there is no teaching or suggestion for the feature of “a pachymetry apparatus” recited in claim 25 or anything remotely similar. In fact, the term “pachymeter” was specifically added to the Cox et al. non-provisional patent application filed on December 20, 2002, and was not included in the provisional application. Compare, U.S. Patent No. 7,130,835 column 4, line 32 with the corresponding paragraph of U.S. provisional application 60/368,643 at pages 5 and 6.

Thus, for the disclosure of “pachymeter”, Cox et al. has an earliest §102(e) prior art date of December 20, 2002. Because the present application has an earlier perfected priority date of March 31, 2002, Cox et al. is not prior art to the present application for that disclosure.

Withdrawal of the rejections to claims 25 and 27 under 35 U.S.C. §102(e) is respectfully requested.

Independent Claim 11:

Independent claim 14 recites a method for controlling a device for an ablation of part of a human eye that includes at least the step of “performing a graphic simulation of the ablation in the form of a graphic visualization.” Support for this feature can be found, for example, in the specification at paragraph [0036], which sets forth that “the established and calculated data can be issued on a computer screen in the form of a graphic simulation. The simulation displays the cornea to be treated for example in different colours or similar in top view or in section so that the doctor in attendance can assess the whole procedure in advance.”

Cox et al. describes a system and method for predictive ophthalmic correction, and merely teaches using “a graphical user interface (GUI) having a display and a selection device that

¹ A further priority claim to U.S. Provisional Application No. 60/340,292, filed on Dec. 14, 2001 is improper since it was filed more than one year prior to the filing date of Cox et al.

facilitates the selection of collected information for analysis with optimized historical information.” See, Cox et al. column 5, lines 6-9. However, there is no indication that GUI of Cox et al. provides a simulation of an ablation as recited in claim 14 nor that such a simulation is graphically visualized. Accordingly, Cox cannot anticipate claim 14 or its dependent claims 15-24, 26 and 28.

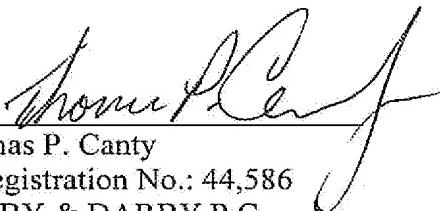
Withdrawal of the rejections to claims 14,-24, 26, and 28 under 35 U.S.C. §102(e) is respectfully requested.

CONCLUSION

For at least the foregoing reasons, the rejections of claims 14-28 are improper, and withdrawal of these rejections and allowance of the application is respectfully requested.

Dated: November 13, 2007

Respectfully submitted,

By 
Thomas P. Carty

Registration No.: 44,586
DARBY & DARBY P.C.
P.O. Box 770
Church Street Station
New York, New York 10008-0770
(212) 527-7700
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant